

Appeal Brief Amendment
Appl. No.: 10/660,337
Submitted July 24, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.:	10/660,337	Confirmation No.:	5985
Applicant:	Ernest et al.		
Filed:	September 11, 2003		
TC/A.U.	2109		
Examiner:	Bryan P. Bui		
Docket No.:	AUS920030409US1		
Customer No.:	46129		
Title:	METHOD AND SYSTEM FOR MANAGING LOCALLY INITIATED ELECTRONIC MAIL ATTACHMENT DOCUMENTS		

Honorable Commissioner
P. O. Box 1450
Alexandria, Virginia 22313-1450

APPEALLANT'S BRIEF
In Response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37)

This amendment is filed in support of the previously filed Appeal Brief in support of the Notice of Appeal, which was filed December 15, 2008 which appealed from the decision of the examiner dated August 14, 2008, rejecting claims 1-4, 7-8, 10, and 12-27. This amendment is in response to a Notification of Non-Compliant Appeal Brief mailed on April 27, 2009.

This amendment contains only the sections that require amendments.

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In the brief, please replace the current section 3 with the below amended section 3.

3. STATUS OF CLAIMS

Claims 1-4, 7-8, 10, and 12-27 are pending in this application; claims 1-4, 7-8, 10, and 12-27 have been appealed. Claims 5, 6, 9 and 11 have been canceled. No claims have been allowed.

In the brief, please replace the current section 6 with the below amended section 6.

6. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

6.A. – Was 35 U.S.C. § 102(e) properly applied against claims 1-4, 7 and 15 through 20 as being anticipated by Malik (US patent 7,003,551)?

6.B. – Was 35 U.S.C. § 103(a) properly applied against claims 8, 10, 12-14 and 21-27 as being unpatentable over Malik in view of Dunn, U.S. Patent Application publication (2004/0034688).

6.C. – Was 35 U.S.C. § 112 second paragraph properly applied to claims 1-4, 7-8, 10 and 12-27 as being indefinite for failing to particularly point out and properly claim the subject matter for which applicant regards as the invention.

In the brief, please replace the current section 7 with the below amended section 7.

7 ARGUMENTS IN SUPPORT OF SEPARATE PATENTABILITY

7a. Arguments in response to 6a.

Initial review of the present invention

Applicants' present invention introduces unique functionality whereby there is a substantial reduction in the storage and replication requirements for the locally initiated electronic mail messages, which include locally sourced attachments. In the method of the present invention, at the origination location of an electronic message, there is an identification of electronic messages containing locally sourced attachment documents. During the storage of the transmitted message, there is determination of whether any attachment to the message was a locally sourced attachment. If the attachment was a locally sourced attachment, the attachment may not be stored with the message. Instead a pointer or link can be created to the original or locally sourced document. This approach will reduce the storage space required by electronic messages.

Initial review of the teachings of Malik

Malik provides an e-mail communications system that minimizes the number of duplicate copies of common attachment files to e-mail communications that are stored in the mail store of an e-mail server. When the e-mail server receives an e-mail attachment file that is larger than a threshold size, the server performs a database search for another copy of the attachment file in the mail store. If another copy is located, the system creates a pointer in the mail store that associates the located attachment file with the e-mail for the additional recipient(s). Attachment files are deleted only after the recipients of the associated e-mail communications delete each of the respective e-mails.

Contrasting Malik with the present invention

Malik appears to be implemented in a configuration that has multiple users and a common store space for email attachments from the multiple users (mail store). The present invention is implemented in a configuration in which the users have individual

storage locations for their attachments. With a multiple user storage configuration, Malik cannot specifically identify the sender of a message that has an attachment that came from the common storage location. With distinct storage location for individual users, the origin of an attachment can be determined in accordance with the present invention.

Applicant's invention includes the limitation of determining an origin of the attachment document to the electronic message, by determining whether the attachment document was created at the location of the sender of the electronic message. Malik does not perform this step. Malik can identify an attachment file from a storage location. However, Malik cannot determine if the attachment was originated at the sender location. For example, if the sender is forwarding a message with an attachment, the sender did not originate that attachment. The present invention would determine that the sender originated the attachment. In that case, the method of the present invention would not be necessary because there is no duplication in storing an attachment document.

In addition, the present invention includes a step that determines if multiple documents are attached to one email message. It is common for a user to attach more than one document to an email message. Contrary to the examiner's assertions, Malik does not teach or anticipate the attachment of multiple documents to an electronic mail message.

In order to sustain a novelty rejection each element of the claim has to be described by the cited reference. In this invention, the step of determining an origin of the attachment to the electronic message, by determining whether the attachment was created at the location of the sender of the electronic message and the step of determining if there are additional attachment documents in the received electronic mail message are not therefore the rejection should be withdrawn.

7b. Arguments in response to 6b.

The examiner states that Malik does not explicitly indicate when the determination is that the attachment document was locally created, determining whether the electronic mail recipient desires to modify the attachment document that was locally created at the destination location of the electronic message. Examiner further asserts

that Dunn discloses when a user desires to modify an attachment a local copy of the document is obtained by the user. First, contrary to the Examiner's assertion, Dunn does not inquire whether a user desires to modify an attachment. In Dunn, the method responds to a modification of the attachment but there is no initial query of the user as described and claimed in the present invention. Second, Dunn obtains a local copy of the attachment to modify. In the present invention, the actual attached document is modified as indicated in Figure 7, steps 78 through 84. Therefore, Applicants submit that the step of determining whether the user desires to modify an attachment is not taught or suggested in Dunn. In addition, with the implementation of the query for modifying the attachment, the present invention automatically deletes the attachment if the determination that there is no desire to modify the attachment. This deletion step is necessary because of the modification query step.

7c. Arguments in response to 6c.

The examiner states that the claims in the invention are indefinite and fail to particularly point out and properly claim the subject matter for which applicant regards as the invention. Applicants attempted to address the particular points of the rejection by amending the claims. However, these amendments were after the final rejection. As a result, the examiner did not enter the amendments to the claims. The examiner asserts that the amendments raised new grounds and would require additional examination.

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REMARKS

Section 3 inadvertently did not list the canceled claims. This section has been amended to list claims 5, 6, 9 and 11 as canceled.

Sections 6 and 7 have been amended to include the section 112 rejection and the arguments on appeal related to that rejection.

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the below listed telephone number. Applicants have petitioned for a one-month extension and have included the appropriate fee for such extension of time.

In view of the above, Applicant respectfully submits Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance.

Respectfully Submitted,



Darcell Walker
Reg. No. 34,945
P. O. Box 25048
Houston, Texas 77265
713-772-1255
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